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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/558,884

11/29/2005

Joerg Fuchslocher

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EXAMINER

PRANGE, SHARON M

ART UNIT

PAPER NUMBER

3728

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/558,884	Applicant(s) FUCHSLOCHER ET AL.	
	Examiner SHARON M. PRANGE	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 17-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 1 in the reply filed on 7/7/09 is acknowledged.

Claims 17-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species 2 and 3, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/7/09.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites that the curved form has portions in the heel portion and forefoot region of the sole portion. However, claim 1 recites in line 12 "the forefoot region has a curved form." This indicates that the curved form is present only in the forefoot region. It is unclear how the curved form extends from the heel portion to the forefoot region, when it is previously recited as only a part of the forefoot region.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 12, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackinsky (US 6,785,984).

Jackinsky discloses a shoe having a sole portion (sole 16). A constraining device (strapping arrangement 30) constrains a wearer's foot from movement when exercising (column 3, lines 7-9; column 8, lines 6-9; Fig. 1). The forefoot region of the sole has a curved form (column 3, lines 58-65; Fig. 1). The forefoot region is further made of a higher density material (particularly sections 20e, 20g), while the heel portion is made of a lower density material. The forefoot region has a thickness greater than the thickness of the heel portion (column 4, lines 45-51; column 5, lines 45-47). The differing thicknesses define an angle of declination (γ) from the forefoot region to the heel portion. The angle of declination is preferably 5 degrees (column 7, lines 20-27; Fig. 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-3, 12, and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Borgeas (US 3,990,159) in view of Girard (US 2002/0007570).

Borgeas discloses a shoe having a sole portion which increases in thickness from the heel portion to the forefoot region. The angle of declination may be 5 degrees (column 5, lines 47-52; Fig. 8, 10). The forefoot region has a curved form. A sidewall portion (ridge 16) extends upwardly to form a circumferential edge. The edge rises higher above the heel portion than the forefoot region (Fig. 8, 10).

Borgeas does not disclose a constraining device that constrains the metatarsal-phalangeal joints.

Girard teaches providing a constraining device (tightening mechanism 64) over the metatarsal-phalangeal joint of the foot. The constraining device helps to constrain the foot while still allowing bending of the footwear (paragraphs 0011, 0012, 0069; Fig. 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a constraining device, as taught by Girard, to the shoe of

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Borgeas in order to better hold the foot in place while exercising while still allowing bending of the footwear.

Borgeas and Girard disclose the claimed invention except for the forefoot region being made of a high density material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the forefoot region of a high density material in order to provide a springing action to the foot. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeas and Girard, as applied to claims 1-3, 12, and 15, further in view of Rudy (US 4,506,460).

The combination of Borgeas and Girard does not disclose a hard, high density insert in the forefoot region.

Rudy teaches providing a hard, high-density insert (moderator 16) in the forefoot region of shoe sole. The insert has a slits (cut-out sections 23, 24) to define the bending moment of inertia. The insert acts to improve the energy absorption, redistribution, storage and energy return of the sole (column 2, lines 38-45; column 10, lines 20-53; column 11, lines 25-31; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided an insert, as taught by Rudy, in order to improve the springing action and energy redistribution of the shoe.

9. Claims 5, 10, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeas, Girard, and Rudy, as applied to claims 4 and 6-9, further in view of Durand (US 7,155,845).

The combination of Borgeas, Girard, and Rudy does not disclose ribs on the insert which pass through the sole to present an exposed surface.

Durand teaches attaching an insert (2) to a sole by providing ribs (lugs 3) which pass through the sole and present an exposed surface (Fig. 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to have attached the insert with ribs passing through the sole, as taught by Durand, as this would be a simple substitution of one way to attach an insert to a sole for another, with the predictable result of providing a secure attachment with increased flexibility. It further would have been obvious to provide the insert in a different color than the sole, as this would be a change in the aesthetic design. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeas and Girard, as applied to claims 1-3, 12, and 15, further in view of Carlson et al. (US 6,362,387), herein Carlson.

The combination of Borgeas and Girard does not disclose a reinforced, padded toe portion.

Carlson teaches providing padding (patches 86, 88, 100) in the toe portion of the

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shoe in order to decrease friction and increase comfort for the wearer (column 7, lines 58-67; column 8, lines 1-43; Fig. 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided padding in the toe portion, as taught by Carlson, in order to improve comfort for the wearer.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 1/14/09
Examiner, Art Unit 3728

/Mickey Yu/
Supervisory Patent Examiner, Art
Unit 3728